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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,503	02/28/2002	Chia-Hu Yu	CFP-12996	2141

7590

03/19/2003

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EXAMINER

LIN, KUANG Y

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS9

<b>Office Action Summary</b>	<b>Application N .</b>		<b>Applicant(s)</b>	
	10/086,503		YU, CHIA-HU	
	<b>Examiner</b>		<b>Art Unit</b>	
	Kuang Y. Lin		1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

1. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 9, there is a lack of antecedent basis in the claim for "the half"; line 13 and 14, respectively, after "speed" a word "of" shall be inserted to render the meaning definite. Claims 3-5 are written in a narrative format rather than an objective format and thereby they do not positively and directly include all the process steps which were referred thereto.

2. Claim 5 contains the trademark/trade name SKD 61 alloy tool steel. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe alloy tool steel and, accordingly, the identification/description is indefinite.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as set forth in page 1 of the instant application as well as pages 1-2 of the copending application S.N. 10/086,504 and further in view of JP 2001-198,662 and Rickman, Jr.

The admitted prior art substantially shows the invention as claimed (applicant is advised that since there is no distinction between the cap as claimed and that of admitted prior art, the cap of the admitted prior art is considered to have no draft) except the hardness of the die surface and the casting speed. However, JP '662 teaches to operate in two speeds during molten metal injection process such that to obtain a casting of high quality. Further, Rickman shows to use die parts having Hv 1400 hardness of die surface (which is higher than H<sub>RC</sub> 70) to prolong the service life thereof. In view of the prior art teaching as a whole, it would have been obvious to provide the high hardness die surface of Rickman in the casting apparatus of the admitted prior art to prolong the service life thereof and to adapt the injection speed of JP '662 to obtain a high quality casting. It would have been obvious to obtain the optimal process parameters through routine experimentation.

5. Claims 1 and 4 are also rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as set forth in page 1 of the instant application as well as pages 1-2 of the copending application S.N. 10/086,504 and further in view of, JP 2001-198,662, Rickman, Jr, and JP 2001-212,659 (assuming that there is a distinction

between the cap as claimed and that of admitted prior art and the cap of the admitted prior art is considered to have draft).

The treatments of applicant's admitted prior art, JP '662 and Rickman are the same as above. JP '659 teaches the concept of using die part without draft and thus to obtain a cast part without draft. The casting so produced does not required troublesome post-machining. It would have been obvious to provide the die parts of the admitted prior art without draft and thus to obtain a die cast cap without draft, and thereby to reduce the cost of manufacture.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as set forth in page 1 of the instant application as well as pages 1-2 of the copending application S.N. 10/086,504 and further in view of, JP 2001-198,662, Rickman, Jr, and JP 2001-212,659 as applied to claim 1 above, and further in view of either Smith or JP 11-77,233.

It would have been obvious to spray the die surface of the admitted prior art with the releasing agent of the either Smith or JP '233 to facilitate the removal of the cap from the casting die.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as set forth in page 1 of the instant application as well as pages 1-2 of the copending application S.N. 10/086,504 and further in view of, JP 2001-198,662, Rickman, Jr, and JP 2001-212,659 as applied to claim 1 above, and further in view of Shibata et al.

It would have been obvious to use the SKD 61 alloy tool steel of Shibata et al for making the die parts of the admitted prior art to prolong the service life thereof.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/086,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed disclosure of the copending application discloses the invention as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuang Y. Lin whose telephone number is 703-308-2322. The examiner can normally be reached on Monday-Friday, 10:00-6:30,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas X Dunn can be reached on 703-308-3318. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9310

for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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March 14, 2003



KUANG Y. LIN  
EXAMINER  
GROUP 320

1725